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Practitioner's Docket No. 350/001/CIP

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the Application of:

Hendrick, Kendall B., et al

Serial No: 09/844,833

Filed: April 27, 2001

For: Automated Microtome Blade Changer

Group No.: 3724

Examiner: Flores Sanchez, Omar

Confirmation No. 2755

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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1. Response to Office Action Mailed on October 3, 2003 - 3 pages

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Signature

(Certification of Facsimile Transmission—page 1 of 1)

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P.O. Box 1450
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Examiner Flores-Sánchez:

This letter responds to the Office Action dated 10/03/03. No extension of time is required for a timely response to this Office Action. However, in the event that this response does not arrive in a timely fashion, then a provisional petition for extension is hereby requested, and the fee therefor may be charged to Deposit Account No. 50-0861.

Comments

Claims 1-15 are pending in the application. Claims 1-15 are subject to restriction by the Office Action of 10/03/03.

1. Restriction/Election Requirement.

Applicants respond to the Examiner's Office Action wherein the Examiner determined that restriction is required for the claims of Group I, (claims 1, 8-13) and Group II (claim 2), III (3-7) and IV (14-15). Applicants respectfully traverse the requirement, for the following reasons.

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A restriction requirement is proper when the inventions are either independent or distinct, and a serious burden would be placed on the examiner to perform the examination. MPEP 803 (1998). The requirements of independence or distinctness are not shown in the combination/subcombinations claimed. The term "dependent" means that there is no disclosed relationship between the two or more subjects disclosed, i.e., they are unconnected in design, operation or effect. MPEP 802.01 (1998). Here the supply blade cartridge is inoperative without the blade changer, because the two are interdependent (see discussion below), not independent. Since the two are connected in operation, the definition of dependent is not met. Further, the distinctness requirement of MPEP 806.0(c) is not met because, contrary to the Examiner's assertions, the microtome blade changing apparatus cannot be used without a supply cartridge, in particular a supply cartridge specifically designed to fit into and be actuated by this blade changer. Additionally, the subcombination blade cartridge cannot be manually actuated to dispense a blade, as described below, therefore it has no separate utility.

The microtome blade changer requires the blade supply cartridge, and vice versa. The blade supply cartridge is specifically designed to mate with the automated blade changer. Note in Fig. 2 that the dispensing tab 90, which is integral to the supply cartridge, is specifically adapted to engage loading segment 30 of the blade changer apparatus. Further, there are safety interlocks 155 that prevent manual disbursement of the blades, so the blade cartridges cannot be used apart from the blade changer apparatus.

For the above reasons, Applicants respectfully submit that the Examiner has not met his burden to show separate utility or independence in the combination/subcombination claimed. Applicants request that the requirement be withdrawn.

2. Provisional Election

Applicants provisionally elect to prosecute the claims of Group I, claims 1 and 8-13, subject to the traversal noted above.

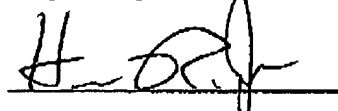
The Examiner is reminded of the Commissioner's Notice of March 26, 1996 at 1184 OG 86. According to that notice, in the case of an elected product claim, rejoinder will be permitted when a product claim is found allowable and the withdrawn process claim depends from and otherwise includes all of the limitations of an allowed product claim. Therefor, the method claims may be rejoined in this case if allowable product subject matter is found. In that event, it may be more efficient for the Examiner to consider those claims with the claims of Group I. In any event one of the groups should be considered in examining all of the claims.

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Applicants specifically reserve the right to further prosecute any of the claims of Groups II-IV at a later time in either this or other applications.

Date: 10/3/03

Respectfully submitted,



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Attorney for Applicants
Reg. No. 33,916